

**REMARKS**

The Office Action requires the Applicant and the assignee of the instant application to provide the following information:

A. Stipulate for the IDS(s) submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004 the following:

Identify 10-20 references considered to be most relevant by Applicants and listed on the IDS(s) submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004.

Under 37 C.F.R. § 1.105, an examiner may “require individuals to submit information as may be reasonably necessary to properly examine or treat the matter” in a pending application. 37 C.F.R. § 1.105(a)(1); cf. MPEP § 704.10. “There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. [An RFI] places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 C.F.R. § 1.105 may only be made when the examiner has a reasonable basis for requiring information.” MPEP § 704.11.

It is well settled that “the terms ‘factual’ and ‘facts’ are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought.” MPEP § 704.11. Thus, requirements under 37 CFR 1.105 may not be used to request opinions that may be held or would be required to be formulated by applicant. *Id.*

Where factual information requested is related to the subject application, the “applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested. Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information.” MPEP § 704.11. Like obligations imposed by the duty of candor and good faith, section

1.105 requires an applicant to submit information already known, “but there is no requirement to search for information that is unknown.” *MPEP* § 704.12(a).

To the extent that the requests for information included in the Office Action are consistent with the principles above, and in furtherance of the principles stated above, Applicant submits the response below to the request for information included in the Office Action. To the extent that the request for information included in the Office Action is intended to solicit opinions from the party or parties from which the information is requested, Applicant respectfully contends that such requests are an improper use of the provisions of 37 CFR 1.105, and Applicant respectfully requests that such requests for information be formally withdrawn by the Examiner.

The instant application is related by priority, subject matter, common specification and/or common inventor with at least a dozen issued U.S. patents of Applicant (“Related Patents”) and/or co-pending U.S. patent applications of Applicant (“Related Applications”). Moreover, many of these patents and patent applications include counterpart patent applications that were filed outside of the United States. A substantial number of the references cited during prosecution of the instant application were cited by the U.S. Patent & Trademark Office or a foreign patent office, during prosecution of such patents and applications.

The U.S. Patent & Trademark Office (the “Office”) encourages applicants to submit references cited in “related” foreign patent applications. In fact, the MPEP recognizes that applicants “have a duty to bring to the attention of the Office any material prior art or other information cited or brought to their attention in any related foreign applications.” *See MPEP 2001.06(a)* (emphasis added). However, there is no requirement that applicants thoroughly and substantively review and compare such references to its pending application.

As the Examiner is undoubtedly aware, the Related Patents were involved in litigation in the U.S. and abroad. A substantial number of the references cited during prosecution were identified during and in conjunction with such litigation. The MPEP encourages applicants to bring to the attention of the Office, the existence of “related litigation” and any other

material information arising therefrom. However, there is no requirement that applicants thoroughly and substantively review and compare such references to its pending application.

The MPEP specifically encourages applicants to submit information to the Office so the examiner can evaluate its relevance to the claimed invention. In fact, the MPEP recognizes that:

when in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided. *See MPEP 2004.*

**RESPONSE**

For the reasons discussed below, one may conclude that the references cited below are among the “most relevant” cited in the IDSs submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004. Pursuant to 37 C.F.R. 1.97(h), no representation is made by the Applicant or Assignee that these references qualify as prior art or that these references are material to patentability of the instant application. Moreover, Applicant has not thoroughly reviewed and analyzed in their entirety each of the references identified in the IDSs submitted 4/5/2004, 4/7/2004, 4/9/2004, and 11/26/2004.

UNITED STATES PATENT NO. 5,372,210<sup>1</sup>

UNITED STATES PATENT NO. 5,730,234<sup>1</sup>

UNITED STATES PATENT NO. 4,815,342<sup>1</sup>

UNITED STATES PATENT NO. 5,415,030<sup>1</sup>

UNITED STATES PATENT NO. 5,794,720<sup>1</sup>

UNITED STATES PATENT NO. 4,393,948<sup>2</sup>

UNITED STATES PATENT NO. 5,224,560<sup>2</sup>

UNITED STATES PATENT NO. 5,605,198<sup>2</sup>

UNITED STATES PATENT NO. 5,010,789<sup>2</sup>

UNITED STATES PATENT NO. 6,142,247<sup>2</sup>

SU 1,768,745<sup>2</sup>

SU 1,441,051<sup>2</sup>

UNITED STATES PATENT NO. 6,412,577<sup>3</sup>

UNITED STATES PATENT NO. 6,095,262<sup>4</sup>

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<sup>1</sup> The instant application is a continuation-in-part of USSN 10/189,305 (now abandoned), which is a continuation of USSN 09/629,344 (now U.S. Patent No. 6,412,577), which is a continuation of USSN 09/387,304 (now U.S. Patent No. 6,095,262), which claims priority to USSN 60/098,422. PCT/US99/19992 also claims priority to USSN 60/098,422. Each of the references identified above with a superscript “1” were cited in the International Search Report regarding PCT/US99/19992.

<sup>2</sup> Each of these references were cited by the Examiner during the prosecution of USSN 10/189,305.

<sup>3</sup> The instant application claims priority to USSN 09/629,344 (now U.S. Patent No. 6,412,577).

EP PATENT NO. EP-B-1117894 -- Communication mailed May 15, 2006<sup>5</sup>

UNITED STATES PATENT NO. 5,197,555<sup>6</sup>

CN 2082755U<sup>6</sup>

M.A. Dekun, *"The Operational Mechanics of the Rock Bit,"* Petroleum Industry Press, Beijing, China, 244 pages (1996)<sup>6</sup>

D. Ma, & J.J. Azar, *"Dynamics of Roller Cone Bits,"* Journal of Energy Resources Technology, Vol. 107 pp. 543-548 (Dec. 1985)<sup>6</sup>

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<sup>4</sup> The instant application claims priority to USSN 09/387,304 (now U.S. Patent No. 6,095,262).

<sup>5</sup> EP Patent No. EP-B-1117894 claims priority to PCT/US99/19992, which claims priority to USSN 60/098,422. The decision revoking EP Patent No. EP-B-1117894 was mailed May 15, 2006.

<sup>6</sup> Each of these references were cited in the Communication mailed May 15, 2006 regarding EP Patent No. EP-B-1117894.

**CONCLUSION**

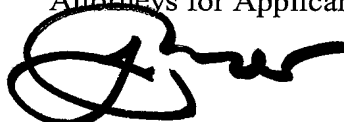
Applicant respectfully requests that the Examiner proceed with substantive examination of all pending claims of the present application.

No fees are believed to be due at this time. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call their attorney at the number listed below.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant



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Date: \_\_\_\_\_

10/7/07

**CORRESPONDENCE ADDRESS:**

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